

REMARKS

Domestic Priority:

Applicant thanks the Examiner for acknowledging Applicant's claim to domestic priority under 35 U.S.C. § 119(e) and to priority under 35 U.S.C. § 120/121.

Drawings:

Applicant notes that a Submission of Drawings will be filed subsequent to the present amendment. Applicant notes that there is no outstanding objection to the drawings.

Allowable Subject Matter:

Applicant sincerely thanks the Examiner for indicating that claims 24-33 and 61-83 have been allowed, and that although claims 23 and 60 have been objected to, these claims would be allowable if written in independent form.

Applicant notes that new claims 85 and 87 have been added, which are merely original claims 23 and 60 written in independent form. Thus Applicant submits that these claims are allowable. Further, Applicant has added new claims 84 and 86, which are original claims 11 and 46 written in independent form. As these claims incorporate similar limitations to allowable claims 23 and 60, Applicant submits that these claims are also allowable.

Further, Applicant notes that the above referenced new claims 84-87 are merely original claims written in independent form, and the original scope or spirit of the claims have not be narrowed, in any way.

Claim Rejections:

Claims 1-83 are all of the claims that have been examined in the present application, and currently claims 1-22 and 34-59 stand rejected. New claims 84-87 have been added and are allowable for the reasons set forth above.

35 U.S.C. § 112, 2nd Paragraph Rejection - Claims 11 and 46:

Claims 11 and 46 have rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite. Specifically, the Examiner has indicated that there is a question regarding which “pad” is being referred to in these claims.

Applicant respectfully disagrees with the Examiner and submits that these claims are clear and definite as they are written. Specifically, Applicant notes that (1) the claims clearly refer to the “pad” and not the “buffer pad”, and (2) claims 11 and 46 clearly refer to removing the “pad” during the unwinding process. Thus, Applicant submits that there is a clear distinction between the “pad” the “buffer pad” in the claims. Because of this, Applicant submits that these claims are clear and definite, such that one of ordinary skill in the art would be able to determine the scope of the claims.

In view of the foregoing, Applicant submits that claims 11 and 46 are definite and clear, and hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 112 rejection of these claims.

35 U.S.C. § 102(b) Rejection - Claims 1-3, 5-8, 12, 13, 15-20, 34-36, 40-43, 45, 47-48, 50-51, 54-57 and 59:

Claims 1-3, 5-8, 12, 13, 15-20, 34-36, 40-43, 45, 47-48, 50-51, 54-57 and 59 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,752,043 to Heinzer. In view of the following discussion, Applicant respectfully traverses the above rejection.

Applicant notes that claims 1, 12, 34 and 47 have been amended as shown in the previous section. Claim 1 has been amended to include the limitations of claim 4, claim 12 has been amended to incorporate the limitations of claims 13 and 14, claim 34 has been amended to incorporate the limitations of claim 37, and claim 47 has been amended to incorporate the limitations of claims 48 and 49. Thus, Applicant submits that Heinzer fails to disclose each and every feature of the claims 1, 12, 34, and 47.

In view of the foregoing, and the amendments to the above claims, Applicant submits that Heinzer fails to disclose each and every feature of the present invention. Therefore, Applicant submits that Heinzer fails to anticipate the present invention, as set forth in claims 1, 12, 34 and 47, and hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 102(b) rejection of these claims. Further, as claims 2-3, 5-8, 13, 15-20, 35-36, 40-43, 45, 48, 50-51, 54-57 and 59 depend on these claims, respectively, Applicant hereby submits that these claims are also allowable, at least by reason of their dependence.

Further, Applicant notes that the amendments to claims 1, 12, 34, and 47 are merely writing original claims 4, 14, 37 and 49 in independent form, and thus the original scope of these claims has not been narrowed, in any way.

35 U.S.C. § 103(a) Rejection - Claims 4, 9-11, 14, 21, 37, 39, 44, 46, 49 and 58:

Claims 4, 9-11, 14, 21, 37, 39, 44, 46, 49 and 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heinzer. In view of the following discussion, Applicant respectfully disagrees.

As an initial matter, Applicant notes that claims 4, 14, 37 and 49 have been cancelled, but their limitations have been incorporated into independent claims, as set forth above. However, Applicant will address the rejection of these claims below, as the overall scope of these claims has been maintained.

In addressing the above rejection, Applicant notes that the Examiner has provided no reference to any portion of Heinzer, or any other reference, which teaches using a buffer pad having a Young's modulus lower than the material being wound. The Examiner merely states that this is simply a matter of design choice. Applicant completely disagrees with the Examiner for at least two reasons.

First, Applicant submits that the Examiner is simply applying a rule of *per se* obviousness by saying that the claimed limitation (regarding the Young's modulus) would have been obvious, without any support. This rule of *per se* obviousness has been found to be inappropriate and unacceptable by the Federal Circuit. See In re Ochiai, 71 F.3d 1565, 1570, 37 U.S.P.Q.2D (BNA) 1127, 1132 (Fed. Cir. 1995). "This method of analysis is founded on legal error because it substitutes supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." In re Ochiai, 71 F.3d 1565, 1570, 37

U.S.P.Q.2D (BNA) 1127, 1132 (Fed. Cir. 1995) In fact, in In re Ochiai, the Court provided a detailed clarification of what it perceived to be a frequent misunderstanding among examiners.

“The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention--including all its limitations--with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract per se rules from decisions that disavow precisely such extraction.” (Emphasis added).

In re Ochiai, 71 F.3d 1565, 1572, 37 U.S.P.Q.2D (BNA) 1127, 1134 (Fed. Cir. 1995).

Second, Applicant submits that even without the Examiner’s inappropriate argument, there is no motivation to modify Heinzer as suggested by the Examiner. Specifically, Applicant notes that the element 4, in Heinzer, is used to ensure that the fibers 5 are properly arranged. Essentially, the fibers 5 are positioned such that they fall in the valleys created by adjacent members 4. Thus, if the members 4 were softer than the fibers 5 they would deform, thus causing the fibers 5 to be out of position. This is clearly to be avoided by the teachings of Heinzer. Thus, one of ordinary skill in the art would have not found it obvious to make the element 4 with a Young’s modulus less than the material wound.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/973,015

Our Ref.: A7909
Art Unit: 2874

In view of the foregoing, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the above claims, and hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of these claims.

35 U.S.C. § 103(a) Rejection - Claims 38 and 52:

Claims 38 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heinzer in view of U.S. Patent No. 5,211,789 to Christian et al. However, as Christian fails to cure the deficient teachings of Heinzer, Applicant submits that these claims are allowable, at least by reason of their dependence

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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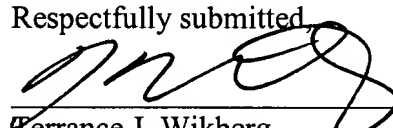
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Respectfully submitted,


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